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**REMARKS**

The undersigned attorney would like to thank Examiner Blanco for discussing the issue of premature finality in interviews and voice mail last week. In the Examiner's last message, he acknowledged that the previous Office Action should not have been final. He requested a new response to the pending Advisory Action, and in response he would withdraw the finality of his earlier action. Accordingly, this new paper includes substantially the same response as was previously filed, including the amendments proposed earlier, for entry and reconsideration by the Examiner.

**Premature Finality**

Initially, it is respectfully requested that the finality of the pending Office Action be withdrawn, because new grounds for rejection were offered that were not necessitated by an amendment or the filing of an information disclosure statement. As an example, claim 3 was amended solely to place it in independent form. Since no change to the scope of that claim was made, the amendment cannot necessitate a new ground of rejection. The Office Action made a new rejection of claim 3 over the Shepard and Yaccarino references, making finality premature.

**Drawing Objections**

Two drawing objections were given in the Office Action. The first alleged that the language of claim 5 is not shown in the drawings, and offered comments pointing out errors concerning a previous explanation of that language. The undersigned thanks the Examiner for those comments, and acknowledges that Figure 4 should have been the major focus of the previous explanation. Figure 4 shows tapered pins (using the same numbers as in Figure 2) in

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the relative positioning suggested by claim 5. As the last third of paragraph 0030 states, Figure 4 indicates that the pins can be placed from opposite sides (as seen in Figure 2) so that one pin's larger end is in the same part of the implant as the other pin's smaller end, and vice versa. Despite the error noted by the Examiner, it is respectfully submitted that Figure 4 considered with Figure 2 illustrates the subject matter of claim 5, and that no drawing changes are necessary.

The second drawing objection concerns claims 8 and 30. As stated in a prior response, all aspects of these claims are shown in the drawings, and therefore no changes are necessary. However, to move this application more quickly to allowance, amendments have been made to claim 8, and claim 30 has been cancelled. As amended, there is no question as to whether the language of those claims is shown in the drawings, and therefore this objection is moot.

#### Provisional Non-Statutory Double Patenting Rejection

As noted in the prior response, the alleged grounds for this rejection are not conceded. The only basis alleged for this rejection is that "both applications claim a fusion implant comprising two bone pieces held together by a pin/member," and therefore they are "not patentably distinct." Respectfully, that basis makes too sweeping a statement about the subject matter of the respective claims and their alleged similarities. It is like saying that respective currently pending claims concerning automobiles are "not patentably distinct" because they each recite four wheels connected to a body. For at least this reason, the non-statutory double patenting rejection should be withdrawn. Further, per MPEP 804, a terminal disclaimer may not be necessary in this case depending on whether any other rejections remain in this case and on the status of the other application. Applicant will submit a terminal disclaimer to obviate this rejection, if it remains necessary, at an appropriate later time.

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Rejection under Section 112

The Office Action asserted a rejection of dependent claim 7 as indefinite. Although this ground is not conceded at least because a proper interpretation can be made of it, claim 7 is being cancelled without prejudice to its refiling in this or a continuing application.

Rejections under Section 102 over U.S. Patent No. 6,761,738 to Boyd

The claims as they stand are allowable over the references relied on by the Examiner for the reasons given in previous responses, and those responses are incorporated by reference herein. The following remarks focus principally on the particular reasoning and responsive comments found in the pending Office Action.

Claims 3, 8, 15-18 and 30 were alleged to be anticipated by Boyd. The initial analysis in the Office Action suggested that items 12 and 14 are the recited first and second pieces of bone that form a construct with exterior surfaces, and item 16 constitutes a pin as recited in the claims. However, the Examiner's comments on page 6 of the Office Action adopt new structure, the exterior of osteogenic material 178 of assembly 160 in Figure 10, as part of the analysis.

It is axiomatic that a reference cannot anticipate unless it shows all elements of the claim arranged as recited in the claim. Respectfully, none of the structure relied on in the Office Action includes all elements of claim 3 arranged as recited in that claim. If the "body" and "pin" of the claim is considered to be items 12, 14 and 16 of Figures 1-2, or items 163, 166 and 142 of Figure 10, then there is no anticipation. It is not explicit or inherent from Figures 1-2 that item 16 is exposed at a first exterior surface but stops short of a second exterior surface. Likewise, Figure 10 clearly shows item 142 extending to the exterior or outermost surfaces of both items 163 and 166. If the "exterior" recited in the claim is considered to be the exterior of item 160 in

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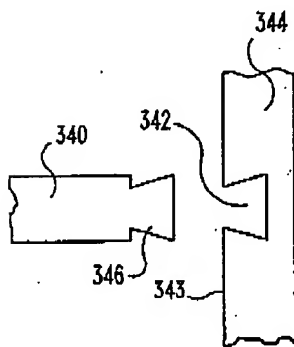
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Figure 10, it is equally clear that neither end of item 142 is exposed from any part of item 160. Simply put, the combination of one exposed end and one non-exposed end is not shown or suggested in any of the particular structures in Boyd relied on by the Examiner. Accordingly, even if all features of claim 3 were seen in some part of the Boyd reference, there has been no showing that all such features are arranged as recited in claim 3.

Claims 4 and 5 recite a tapering pin such that a larger portion of the pin is near a first exterior surface and a smaller portion is near the second exterior surface. The Office Action



**Fig. 20**

suggests that dovetail portion 346 in Figure 20 constitutes such a tapered portion, but again that structure is not arranged as recited in the claim. In Boyd's Figure 20, left, one side portion or "strut" 344 is shown, and item 343 is an interior portion that faces another strut. Accordingly, the large end of 346 may be near a first exterior surface of the overall construct (i.e. the unnumbered surface of 344), but it clearly is not near the exterior surface of the unseen other strut.

Claim 6 recites that axes of the tapered pins cross each other at a given distance. Clearly Figure 20 does not show any alleged pins crossing each other. Even if it can legitimately be considered that the dovetail of Figure 20 can be imported to the cross-pieces of Figures 1-2, it still would not provide the crossing axes spaced the given distance, as recited in claim 6.

Although claim 8 is believed to define over the relied-on references, and thus no amendments are necessary, in order to move this case forward more quickly claim 8 has been amended as indicated above. In addition to the points made in previous responses, the Boyd reference does not show the oblique orientation, holes that extend toward but not through an

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outer surface of a bone piece, or pins having longitudinal axes that are non-coplanar, as recited in claim 8. Boyd shows items 140 and 142 that are perpendicular to outer surfaces of pieces 132, 134 and 136, and the holes through those pieces are not oblique to their outer surfaces, as recited in claim 8. Further, items 140 and 140 are parallel to each other, meaning that they are coplanar.

The claims dependent from claim 8 are allowable based on that dependence and/or on their own merit. For example, the features of claim 16 were not addressed by the Office Action, and therefore a proper *prima facie* case of anticipation has not been made.

Rejections under Section 103 over U.S. Patent No. 6,855,167 to Shimp

Claims 3-8, and 18 were rejected as allegedly obvious over the Shimp reference by itself. As with other rejections, this ground is not conceded, at least for reasons given in prior responses to Office Actions, and thus no amendments are necessary. The above amendment to claim 3 provides an additional difference over the Shimp reference, since the reference does not show or suggest that two bone pieces are not in contact and border an empty space between them.

Rejections under Section 103 over U.S. Publication No. 2004/0078078 to Shepard and U.S. Patent No. 7,044,968 to Yaccarino

Claims 3, 4 and 18 were rejected as allegedly obvious over the Shepard and Yaccarino references. Although the positions in the Office Action are not conceded, to move these claims more quickly to allowance the amendments above to claim 3 have been made. In addition to points made previously, it is noted that Shepard does not show or suggest an implant having two bone pieces not in contact with each other. It must also be noticed that modifying items in Shepard to have such a feature would run against Shepard's fundamental principles.

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Rejections under Section 103 over Shimp and U.S. Publication No. 2002/0107572 to Foley

Claims 21-24 were rejected over the combination of the Shimp and Foley references. In addition to the remarks previously made overcoming this rejection, which are incorporated by reference herein, these claims have been made dependent from claim 8, and they are therefore allowable on that basis as well.

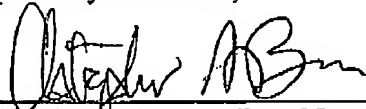
New Claims

New claims 43-48 have been offered, and are allowable over the references relied on in the Office Action. Like claim 8, claim 43 defines features and/or relationships that are not shown in any of the relied-on references. Claims 44-47 are dependent from claims 8 or 43, and are allowable on that basis and/or on their own merit. The new claims are supported at least by Figures 1-3 and the associated text. No new matter has been added.

The claims cancelled previously or herein have been cancelled without prejudice to reconsideration in this or a continuing application. No admissions are made as to patentability of any cancelled claim.

In conclusion, reconsideration of this application in view of the amendments and arguments made above is respectfully requested. The pending claims are believed to be in condition for allowance, and a Notice of Allowance is respectfully solicited.

Respectfully submitted,



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